

## REMARKS

### I. Status of the Claims

Claims 1, 10, 11 have been amended. Claims 1-20 are currently pending.

### II. Rejections Under 35 U.S.C. § 102(b)

#### ***Prima Facie Anticipation***

In order to successfully set forth a rejection to a claim under 35 U.S.C. § 102, a prima facie case of unpatentability must be established by the Examiner. A general definition of *prima facie* unpatentability is provided at 37 C.F.R. §1.56(b)(2)(ii):

*A prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability. (emphasis added)*

"Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983) (citing *Soundsciber Corp. v. United States*, 360 F.2d 954, 960, 148 USPQ 298, 301 (Ct. Cl.), *adopted*, 149 USPQ 640 (Ct. Cl. 1966)), *cert. denied*, 469 U.S. 851 (1984). Thus, to anticipate Applicant's claims, the reference or references utilized as a basis for the rejection under 35 U.S.C. § 102 must disclose each element recited therein. "There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the

invention." *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ 2d 1001, 1010 (Fed. Cir. 1991).

To overcome the anticipation rejection, the applicants need only demonstrate that not all elements of a *prima facie* case of anticipation have been met, *i. e.*, show that the reference or references cited by the Examiner fails to disclose every element in each of the applicants' claims. "If the examination at the initial state does not produce a prima face case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443, 1444 (Fed. Cir. 1992).

***Kurtz et al.***

Claims 1-4, 7, 8, 10-15 and 19 were rejected under 35 U.S.C. § 102(b) as being anticipated by Kurtz et al. (U.S. Patent No. 5,999,082).

Regarding claims 1, 3, 4, 10, 11, 14, the Examiner argued that Kurtz et al teaches a sensor element (citing col. 2, line 50 of Kurtz et al) located on a base 15; a cover (citing col. 3, lines 28-40 of Kurtz et al) located proximate to said base, wherein said cover comprises a sensor diaphragm 21 and a dimple 20 that form a part of the cover (citing col. 3, lines 28-40 of Kurtz et al); and a flanged area (citing col. 4, line 62, col. 2, line 25 of Kurtz et al) formed to a bottom portion of the cover, wherein the flanged area provides a surface for contacting a fixture 18 to which the sensor apparatus attaches and holding the sensor apparatus to the fixture in a manner which prevents the sensor diaphragm from contacting the fixture and including errors during sensor operations thereof (citing abstract lines 8-10 of Kurtz et al).

The Applicants respectfully disagree with this assessment. The Examiner argued that reference numeral 15 of Kurtz et al refers to a "base". Kurtz et al, however, does not refer to reference numeral 15 as being a base, but instead refers to reference numeral 15 as a "sensor structure" which is mounted below the top surface of a base plate 18 (*i.e.*, see col. 3, lines 32-33). Such an

arrangement contradicts the Examiner's argument that a sensor element is located on the component referred to be reference numeral 15.

The Examiner additionally argued that reference numeral 20 refers to a "dimple". A review of Kurtz et al discloses, however, that reference numeral 20 is not a dimple as taught by Applicants' claims 1, 3, 4, 10, 11, 14, but is instead an "upward dimple, a projection or a dome" (i.e., see col. 3, line lines 34-35). Applicants' amended claims 1, 10, and 11, for example, teaches an inward dimple that is formed into and a part of said cover" rather than an "upward dimple" or "projection or dome" as taught by Kurtz et al. It is believed that support for the amendments of claims 1, 10, and 11 is adequately provided by Applicants' specification. For example, see reference numeral 102 of FIGS 1-3, which clearly shows an inwardly formed dimple.

The Examiner additionally argued that Kurtz et al d discloses a flanged area (citing col. 4, line 62, col. 2, line 25 of Kurtz et al) formed to a bottom portion of the cover, wherein the flanged area provides a surface for contacting a fixture to which the sensor apparatus attaches and holding the sensor apparatus to the fixture in a manner which prevents the sensor diaphragm from contacting the fixture and including errors during sensor operations thereof. Col. 4, lines 62 and col. 2, line 25 Kurtz et al refer to a "peripheral flange" but do not indicate that such a peripheral flange a surface for contacting a fixture to which the sensor apparatus attaches and holding the sensor apparatus to the fixture in a manner which prevents the sensor diaphragm from contacting the fixture and including errors during sensor operations thereof.

The Examiner has not provided evidence from Kurtz et al explaining how the "peripheral flange" provides a surface contacting a "fixture" to which the sensor apparatus attaches, etc. Instead, the Examiner argued that reference numeral 18 refers to such a "fixture". A ready of Kurtz et al indicates, however, that reference numeral 18 refers to a "metal header" (i.e., see col. 2, line 54 of Kurtz et al) and to a base plate (i.e., see col. 3, line 31 of Kurtz et al). The Examiner additionally cited the abstract lines 8-10 of Kurtz et al. Applicants note,

however, that such language does not explain how the sensor diaphragm of Kurtz et al is preventing from contacting the fixture and including errors during sensor operations thereof.

Regarding claims 2, 12 and 13, the Examiner argued that Kurtz et al teaches the flanged area (citing col. 4, line 62 and col. 2, line 25 of Kurtz et al) connected to and surrounds the bottom portion of the cover 20 and is further positioned parallel to the sensor diaphragm (citing Fig. 2). The Applicants respectfully disagree with this assessment. Col. 4, line 62 of Kurtz et al indicates a "flanged area", but does not explain how the flanged area connects to and interacts with and surrounds a bottom portion of the cover 20. Similarly, col. 2, line 25 of Kurtz et al indicates a "flanged area", but again, does not explain how the how the flanged area connects to and surrounds a bottom portion of the cover 20. Additionally, Applicants note that Fig. 2 does not indicated "parallel positioning". The Examiner has not explained how Fig. 2 discloses such "parallel positioning".

The Applicants remind the Examiner that as indicated above with respect to prima facie anticipation, in order to set forth a rejection to claims 1-4, 7, 8, 10-15 and 19 as being anticipated by Kurtz et al under 35 U.S.C. § 102, the Kurtz et al must show every feature and limitation of the rejected claim(s). If even one feature is lacking in the cited reference, the rejection must be withdrawn. For example, Kurtz et al does not disclose an "inward dimple" but instead shows a protruded dimple.

Thus, the Examiner has not identified each and every feature and limitation of Applicant's claims 1-4, 7, 8, 10-15 and 19 in Kurtz et al. The Applicants therefore respectfully request that the rejection to claims 1-4, 7, 8, 10-15 and 19 under 35 U.S.C. § 102 be withdrawn.

Regarding claim 7, the Examiner argued that Kurtz et al teaches that said sensor element comprises silicon (citing the abstract of Kurtz et al). Applicants submit that the arguments presented above with respect to claims 1-4, 7, 8, 10-

15 and 19 under 35 U.S.C. § 102 apply equally to the rejection to claim 7. Thus, Applicants respectfully request that the rejection to claim 7 be withdrawn.

Regarding claims 8, 15 and 19, the Examiner argued that Kurtz et al teaches a pressure sensor (citing col. 4, line 55 of the abstract). Applicants submit that the arguments presented above with respect to claims 1-4, 7, 8, 10-15 and 19 under 35 U.S.C. § 102 apply equally to the rejection to claims 8, 15 and 19. Thus, Applicants respectfully request that the rejection to claims 8, 15 and 19 be withdrawn.

## **II. Rejections Under 35 U.S.C. § 103**

### ***Requirements for Prima Facie Obviousness***

The obligation of the examiner to go forward and produce reasoning and evidence in support of obviousness under 35 U.S.C. § 103 is clearly defined at M.P.E.P. §2142:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

M.P.E.P. §2143 sets out the three basic criteria that a patent examiner must satisfy to establish a *prima facie* case of obviousness:

1. some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
2. a reasonable expectation of success; and
3. the teaching or suggestion of all the claim limitations by the prior art reference (or references when combined).

It follows that in the absence of such a *prima facie* showing of obviousness by the examiner (assuming there are no objections or other grounds for

rejection), an applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443 (Fed. Cir. 1992).

Thus, in order to support an obviousness rejection, the Examiner is obliged to produce evidence compelling a conclusion that each of the three aforementioned basic criteria has been met.

***Kurtz et al.***

Claims 5, 6, 9, 16, 17 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable Kurtz et al. (U.S. Patent No. 5,999,082). Regarding claims 5, 6, 9, 16, 17 and 20, the Examiner argued that Kurtz et al teaches silicon and a pressure sensor but admitted that Kurtz et al does not explicitly teach quartz, ceramic or a SAW pressure sensor. The Examiner stated, however, that lacking any criticality, it would have been obvious to one having ordinary skill in the art of pressure transducers at the time the invention was made to modify Kurtz et al with ceramic, quartz or a SAW pressure sensor since it has been held to be within the general skill of a worker in the art to select a material on the basis of its suitability and intended use. The Examiner asserted that in this particular case, it would have been obvious to select the most feasible material readily available to the manufacture after undo experimentation for the purpose of creating a pressure transducer that operates at optimum performance.

The Applicants respectfully disagree with this assessment. Applicants note that the arguments presented earlier with respect to the rejection to claims 1-4, 7, 8, 10-15 and 19 under 35 U.S.C. § 102(b) apply equally to the present rejection to claims 5, 6, 9, 16, 17 and 20 under 35 U.S.C. § 103(a). The Applicants note that the use of a SAW pressure sensor is not necessarily an obvious choice in selecting the most feasible material readily available to the manufacture after undo experimentation. In fact, neither Applicants' specification nor the Kurtz et al reference indicate "undo experimentation" for the selection of either ceramic, quartz or a SAW pressure sensor.

The applicants additionally assert that the rejection to claims 5, 6, 9, 16, 17 and 20 herein fails under all three prongs of the aforementioned obviousness test because Kurtz et al neither teaches nor suggests all of the limitations set out in Applicants' amended claims 5, 6, 9, 16, 17 and 20.

First, the Examiner has not provided suggestion or motivation in the Kurtz et al references itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference to provide all of the limitations of Applicants' claims 5, 6, 9, 16, 17 and 20. For example, the Examiner argued that it would have been obvious to one having ordinary skill in the art of pressure transducers at the time the invention was made to modify Kurtz et al with ceramic, quartz or a SAW pressure sensor since it has been held to be within the general skill of a worker in the art to select a material on the basis of its suitability and intended use. A motivation for such a modification must be provided in the cited reference, Kurtz et al. The Examiner has not provided a reasoning for such a motivation, based on the language of the Kurtz et al reference.

Second the Examiner has not provided an explanation of why a reasonable expectation of success would accrue from such a modification. Third, the Examiner has not provided the teaching or suggestion of all the claim limitations by the Kurtz et al reference.

The Applicants separately contends that the rejection fails to satisfy first prong because, in view of the objectives and teachings of the Kurtz et al reference, there is no motivation or suggestion to modify the Kurtz et al reference to provide for all of the features of Applicants' claims 5, 6, 9, 16, 17 and 20. In this regard, the teaching or suggestion to make the modification and the reasonable expectation of success must both be found in the Kurtz et al reference, not in the applicants' disclosure.

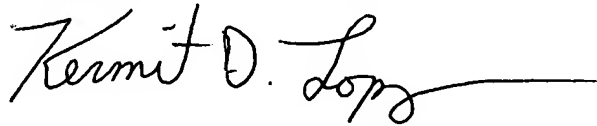
Based on the foregoing, Applicants submit that the rejection to claims 5, 6, 9, 16, 17 and 20 under 35 U.S.C. § 103(a) has been traversed. Applicants therefore request withdrawal of this rejection.

### **III. Conclusion**

~~In view of the foregoing remarks, the Applicants submit that Applicants'~~  
claims are patentably distinct over the prior art references and are in allowable form. Accordingly, the Applicant earnestly solicit the favorable consideration of their application, and respectfully request that it be passed to issue in its present condition.

Should the Examiner discern any remaining impediment to the prompt allowance of the aforementioned claims that might be resolved or overcome with the aid a telephone conference, he is cordially invited to call the undersigned at the telephone number set out below.

Respectfully submitted,

A handwritten signature in black ink that reads "Kermit D. Lopez". The signature is fluid and cursive, with a long horizontal line extending from the end of the name.

Kermit D. Lopez  
Reg. No. 41,953  
ORTIZ & LOPEZ, PLLC  
P.O. Box 4484  
Albuquerque, NM 87196-4484

ATTORNEYS FOR APPLICANTS